

## II. General Remarks Concerning This Response

Claims 1-4, 7-10, and 13-16 are currently pending in the present application. Claims 1, 7, and 13 have been amended; no claims have been added; and claims 5, 6, 11, 12, 17, and 18 have been canceled in this response. Reconsideration of the claims is respectfully requested.

## III. Summary of Present Invention

A method, system, apparatus, and computer program product is presented for management of a distributed data processing system. A network management framework provides the ability to restrict the use of endpoint resources by receiving a request from a source endpoint for a particular type of action at a target endpoint. A topology mapping is used to derive an endpoint-to-endpoint route for completing the requested action. Other activities along the route are restricted or terminated on an endpoint-by-endpoint basis as necessary in accordance with the derived endpoint-to-endpoint route.

## IV. 35 U.S.C. § 101-Double Patenting

The Office action has rejected claims 1-33 of the present patent application in an obviousness-type double patenting rejection over claims 1-33 of co-pending U.S. patent application 09/737,725, which is also assigned to IBM and has common co-inventors with the present application. This rejection is respectfully traversed.

MPEP § 804 states the following:

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obviousness-type double patenting analysis.

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Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims -- a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

The claims in the two patent applications clearly differ from each other; in fact, one independent claim from each patent application was copied into the Office action. For example, the independent claims of the other patent application include an element similar to "identifying a set of supported protocols that are common to the set of devices along the logical route" and another element similar to "determining a set of allowable supported protocols in the set of supported protocols that can be used to complete the action"; neither of these elements appear in the present patent application. In addition, the independent claims of the present patent application include an element similar to "securing, in response to a determination that completion of the action requires that the set of resources operate at high levels of performance, operating conditions within the distributed data processing system for high levels of performance by the set of resources and the target resource"; this element does not appear in the claims of the other patent application. The simple fact that the claims in the different patent application may have common elements does not provide a basis for an obviousness-type double patenting rejection.

Applicant also notes that the rejections that have been provided by the Patent Office in the respective Office actions on these patent applications have used completely different prior art references for rejecting the claims in each patent application, even though the rejections were written by the same examiner. One of ordinary skill in the art would reason that if

the claims in the two patent applications are so similar as to warrant a double patenting rejection, then at least one rejection in each patent application would be based on a common prior art reference. Applicant asserts that the differing, multiple,  
5 grounds of rejection support the contention that the respective claims in each patent application are not so similar as to be obvious in view of each other.

More importantly, the rejection does not provide any reasons why a person of ordinary skill in the art would conclude that the  
10 invention defined in the claims of the present patent application is an obvious variation of the invention defined in the claims in the other patent application, as is required by a proper obviousness-type double patenting rejection. The onus is on the Patent Office for explaining the reasoning behind the rejection;  
15 without any reasoning against which to argue, Applicant cannot provide any arguments against the hypothetical reasoning. Applicant requests the withdrawal of the double patenting rejection.

20 **V. 35 U.S.C. § 102(e)-Anticipation-Dowd et al.**

The Office action has rejected claims 1-18 under 35 U.S.C. § 102(b) as anticipated by Dowd et al., "Firewall Security Apparatus for High-Speed Circuit Switched Networks", U.S. Patent No. 6,141,755, filed 04/13/1998, issued 10/31/2000. This  
25 rejection is respectfully traversed.

The independent claims have been amended to incorporate the features from two dependent claims; for example, claims 5 and 6 have been canceled while incorporating their subject matter into independent claim 1. The rejection is completely silent with  
30 respect to the feature of "selecting means for selecting the logical route, wherein the logical route does not include resources for which exclusive access has previously been granted", e.g., as recited in original claim 12 (now in

independent claim 7) and similarly within original claims 6 and 18.

Applicant asserts that the rejection is silent with respect to this feature because Dowd et al. does not disclose this feature. Dowd et al. clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Dowd et al. cannot be used as an anticipatory reference, and the rejection of the claims has been overcome, whereby Applicant requests the withdrawal of the rejection.

Independent claim 1 is directed to a method; claim 7 is directed to an apparatus; and claim 13 is directed to a computer program product. The Office action uses an anticipation argument against claims 1 and 13 by relying the argument that is used against claim 7. Applicant's argument with respect to the rejection of claim 7 is similarly applicable against the rejection of claims 1 and 13.

#### **VI. 35 U.S.C. § 102(e)-Anticipation-Srivastava et al.**

The Office action has rejected claims 1-18 under 35 U.S.C. § 102(b) as anticipated by Srivastava et al., "Method and Apparatus for Distributing and Updating Group Controllers over a Wide Area Network Using a Tree Structure", U.S. Patent No. 6,684,331, filed 12/22/1999, issued 01/27/2004. This rejection is respectfully traversed.

The independent claims have been amended to incorporate the features from two dependent claims; for example, claims 5 and 6 have been canceled while incorporating their subject matter into independent claim 1. One of the amended features includes  
5 "selecting means for selecting the logical route, wherein the logical route does not include resources for which exclusive access has previously been granted", e.g., as recited in original claim 12 (now in independent claim 7) and similarly within original claims 6 and 18.

10 The rejection states that Srivastava et al. discloses this feature as "an intermediate node has a separated secured private channel, col 16 line 6--col 17 line 5], which is clearly not an equivalent feature.

15 Srivastava et al. clearly does not disclose features as required by the language of the claims of the present application. As stated at MPEP § 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of*  
20 *California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Hence, for this and other reasons, Srivastava et al.  
25 cannot be used as an anticipatory reference, and the rejection of the claims has been overcome, whereby Applicant requests the withdrawal of the rejection.

30 Independent claim 1 is directed to a method; claim 7 is directed to an apparatus; and claim 13 is directed to a computer program product. The Office action uses an anticipation argument against claims 1 and 13 by relying the argument that is used against claim 7. Applicant's argument with respect to the

rejection of claim 7 is similarly applicable against the rejection of claims 1 and 13.

**VII. 35 U.S.C. § 103(a)–Obviousness–Huang in view of Kawai**

5       The Office action has rejected claims 1-13 under 35 U.S.C. § 103(a) as unpatentable over Huang et al., "Ripple Scheduling for End-to-End Global Resource Management", U.S. Patent Number 6,446,125 B1, filed 03/28/1997, issued 09/03/2002, in view of Kawai et al., "Bandwidth Control Apparatus", U.S. Patent Number 10   6,687,225 B1, filed 10/19/1999, issued 02/03/2004. This rejection is traversed.

15       The independent claims have been amended to incorporate the features from two dependent claims; for example, claims 5 and 6 have been canceled while incorporating their subject matter into independent claim 1. The rejection is completely silent with respect to the feature of "selecting means for selecting the logical route, wherein the logical route does not include resources for which exclusive access has previously been granted", e.g., as recited in original claim 12 (now in 20   independent claim 7) and similarly within original claims 6 and 18. The rejection states that such a feature is "a design choice". Applicant asserts that the rejection is silent with respect to this feature because neither Huang et al. nor Kawai et al. disclose this feature. Huang et al. and Kawai et al. 25   clearly do not disclose features as required by the language of the claims of the present application.

**Examiner bears the burden of establishing a *prima facie* case of obviousness**

30       The examiner bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Only when a *prima facie* case of

obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). In response to an assertion of obviousness by the Patent Office, the applicant may attack the Patent Office's *prima facie* determination as improperly made out, present objective evidence tending to support a conclusion of nonobviousness, or both. *In re Fritch*, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Huang et al. and Kawarai et al. clearly fail to disclose at least one feature of the present invention as recited within each independent claim, notwithstanding the anticipation arguments presented by the Office action, thereby rendering Huang et al. and Kawarai et al. incapable of being used as primary and secondary references as argued by the current rejection. Moreover, a hypothetical combination of Huang et al. and Kawarai et al. would also fail to reach the claimed invention of the present patent application. As should be recognized, because both the primary and secondary references in the rejection fail to disclose the claimed features against which the references were applied, and because the references fail to be combinable to produce these claimed features, the rejection fails to fulfill the requirements of a proper obviousness argument.

With respect to the claims of the present patent application, Applicant respectfully submits that it would not have been obvious for one having ordinary skill in the art to have used the applied prior art references to reach the claimed invention. Hence, a rejection of the claims cannot be based upon

the cited prior art to establish a *prima facie* case of obviousness. Therefore, a rejection of the claims under 35 U.S.C. § 103(a) has been shown to be insupportable in view of the cited prior art, and the claims are patentable over the applied references. Applicant respectfully requests the withdrawal of the rejection of the claims.

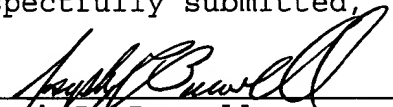
**VIII. Conclusion**

It is respectfully urged that the present patent application is patentable, and Applicant kindly requests a Notice of Allowance.

For any other outstanding matters or issues, the examiner is urged to call or fax the below-listed telephone numbers to expedite the prosecution and examination of this application.

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Respectfully submitted,

  
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Joseph R. Burwell  
Reg. No. 44,468  
ATTORNEY FOR APPLICANT

Law Office of Joseph R. Burwell  
P.O. Box 28022  
Austin, Texas 78755-8022  
Voice: 866-728-3688 (866-PATENT8)  
Fax: 866-728-3680 (866-PATENT0)  
Email: joe@burwell.biz